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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,958	06/20/2003	Mitchell H. Herring	4927.001	6575

7590 09/07/2005

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EXAMINER

PRICE, CARL D

ART UNIT	PAPER NUMBER
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3749

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/600,958

Applicant(s)

HERRING, MITCHELL H.

Examiner

CARL D. PRICE

Art Unit

3749

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4, 8 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4, 8 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/22/2005 has been entered.

Response to Arguments

Applicant's arguments with respect to claims 4, 8 and 9 have been considered but are moot in view of the new ground(s) of rejection.

Applicant has amended the claims to be of a scope not previously presented. For example, scope of the claimed invention presently requires "a first elongated arm having a perpendicularly projecting firebox engaging flange"; "by at least one hinge" and "the pivot pin being telescopically adjustable to allow for longitudinal adjustment thereof.... on a wide variety of barbeque grills". Newly discovered prior art references of **US002653036 (CREEL et al)** and **US002704063 (YOUNG)** have now been cited and/or relied upon to address the scope of applicant's claimed invention. See below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 8: Rejected under 35 U.S.C. 103(a)

Claims 4 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over **US002653036 (CREEL et al)** or **US002704063 (YOUNG)** (both newly cited) in view of **US003731342 (COUSIN)**(of record).

In regard to the claims, the recitation “for propping open the cover of a barbecue grill of the type having a fire box and a cover pivotally connected to the firebox” (claims 4 and 8) has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). In addition, the recitations such as “whereby the apparatus *may be* installed on a barbecue grill ...” (claims 4 and 8); and the term and a “fire” box (claim 9) are deemed a recitation of the intended use of the claimed invention and does not result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

US002653036 (CREEL et al) shows an apparatus comprising:

- a first elongate arm (12, 14) having a perpendicularly projecting flange (13);
- a second elongate arm (22, 22') having a perpendicularly projecting flange (33);
- the first elongate arm adapted with an end portion having an arc-shaped edge (14) defining a plurality of peripheral notches (19, 21);
- the second elongate arm adapted with an end portion defining a projecting member (24) sized to be received within the notches;

- the first elongate arm end portion defining a generally circular aperture (i.e. – “a rod or pin 16 which passes through suitable openings in portions 14 and projects outwardly from each side thereof.”), and
- the second elongate arm end portion defining a generally slotted aperture (23);
- the first and second arms being adjustable in angular relation by pivotal rotation about the pivot pin and fixed in one of a plurality of annular positions by inserted engagement of the second arm projecting member in one of the first arm notches by relative sliding movement between the first and second arms facilitated by the second arm slotted aperture (see column 2, line 27- 49).

Applicant's attention is further directed to the alternative configurations of the detents and projections of **US002653036 (CREEL et al)**, discussed in column 2, line 50- column 3, line 14.

US002704063 (YOUNG) shows an apparatus comprising:

- a first elongate arm having a perpendicularly projecting flange (5);
- a second elongate arm (4, 13) having a perpendicularly projecting flange (22);
- the first elongate arm adapted with an end portion having an arc-shaped edge (14) defining a plurality of peripheral notches (not referenced (i.e. – adjacent 16 and 15);
- the second elongate arm adapted with an end portion defining a projecting member (15 or 26) sized to be received within the notches;
- the first elongate arm end portion defining a generally circular aperture (i.e. – “A hinge pin 11 rigidly secured to the lower portion of hinge bracket 5 extends through and cooperates with vertical slot 12 in hinge member or bracket 13 to form a pin and slot connection.”), and
- the second elongate arm end portion defining a generally slotted aperture (12);
- the first and second arms being adjustable in angular relation by pivotal rotation about the pivot pin and fixed in one of a plurality of annular positions by inserted engagement of the second arm projecting member in one of the

first arm notches by relative sliding movement between the first and second arms facilitated by the second arm slotted aperture (see column 3, lines 7-39).

US002653036 (CREEL et al) and **US002704063 (YOUNG)** show and disclose the invention substantially as set forth in the claims with possible exception to:

- a telescopically adjustable pivot pin pivotally connecting the first and second elongate arms by insertion through the first and second arm end portion apertures.

US003731342 (COUSIN) teaches, from the same hinge field of endeavor as **US002653036 (CREEL et al)** and **US002704063 (YOUNG)**, a telescopically adjustable pivot pin pivotally connecting the first and second elongate arms by insertion through the first and second arm end portion apertures.

US003731342 (COUSIN) shows and discloses apparatus for propping open a cover, the apparatus including:

- means (1) for engaging a first member (4);
- means (2) for engaging a second member (5);
- the means for engaging the first member includes a first elongate arm (1) integrally formed with a perpendicularly projecting flange (1); and
- the means for engaging the second member includes a second elongate arm (2) integrally formed with a perpendicularly projecting flange (2); and
- means (16, 17) for pivotally connecting the means for engaging the first and second members; and
- wherein the first elongate arm has an end portion having an arc-shaped edge defining a plurality of notches (6) and the second elongate arm has an end portion defining a projecting member (11) sized to be received within the notches;
- wherein the means for pivotally connecting the means for engaging the first and second members includes a telescopically adjustable pivot pin (33).

In regard to claims 4 and 8, for the purpose of accommodating various sized hinged apparatus, it would have been obvious to a person having ordinary skill in the art to modify the hinge arrangement of either **US002653036 (CREEL et al)** or **US002704063 (YOUNG)** to include a telescopically adjustable pivot pin pivotally connecting the first and second elongate arms by insertion through the first and second arm end portion apertures, in view of the teaching of **US003731342 (COUSIN)**.

Claim 9: Rejected under 35 U.S.C. 103(a)

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over **US002653036 (CREEL et al)** or **US002704063 (YOUNG)** in view of **US003731342 (COUSIN)** as applied to claims 4 and 8 above, and further in view of **US006705306 (DICKEY)**.

US002653036 (CREEL et al) and **US002704063 (YOUNG)** show and disclose the invention substantially as set forth in the claims with possible exception to:

- Applying the hinge apparatus to a barbecue grill whereby the cover may be selectively positioned from a closed configuration in covering relation with the firebox, to a plurality of angularly open configurations corresponding to the first and second arm angular positions by engagement of the second arm projecting member in one of the first arm notches.

US006705306 (DICKEY) teaches applying a hinge apparatus to a barbecue grill whereby the cover may be selectively positioned from a closed configuration in covering relation with the firebox, to a plurality of angularly open configurations corresponding to the first and second arm angular positions by engagement of the second arm projecting member in one of the first arm notches.

Art Unit: 3749

In regard to claim 9, for the purpose of permitting a barbecue grill cover to be selectively positioned from a closed configuration in covering relation with a firebox, it would have been obvious to a person having ordinary skill in the art to make use of a hinge such as those disclosed in **US002653036 (CREEL et al)** and **US002704063 (YOUNG)** to adjustably and selectively support a barbecue grill fire box cover in the manner taught by **US006705306 (DICKEY)**.

Conclusion

See the attached PTO FORM for prior art made of record that is not relied upon, which is considered pertinent to applicant's disclosure.

USPTO CUSTOMER CONTACT INFORMATION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARL D. PRICE whose telephone number is (571) 272-4880. The examiner can normally be reached on Monday through Friday between 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on (571) 272-4475 4860. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3749

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Carl D. Price', with a large, stylized loop at the end.

CARL D. PRICE
Primary Examiner
Art Unit 3749

cp